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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/092,922 | 03/08/2002 | Takayuki Sano | 50233-097 | 1295 |

7590 12/30/2003

McDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

RODEE, CHRISTOPHER D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1756

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,922

Applicant(s)

SANO ET AL.

Examiner

Christopher D RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5-8,10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,5-8,10 and 13 is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

The certified translations of the '883 and '680 priority documents have been received. The certified translations state a filing date for these foreign applications of May 12, 2001 and May 21, 2001, respectively. See cover page of each publication. A review of the actual foreign documents shows filing dates of March 12, 2001 and March 21, 2001, which are earlier than the § 102(e) date of the Arai Patent Application Publication. It appears that the indication of "May" dates were inadvertent errors during translation of the priority documents. The priority claim has been considered based on the "March" 2001 dates stated on the priority documents.

Claim Rejections - 35 USC § 103

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arai in US Patent Publication 2001/0053491.

This reference was applied in the last Office action. In an effort to remove the reference as competent prior art applicants have submitted a certified translation and relied upon the '883 priority document. See 37 CFR 1.55. The '883 priority document has an effective date (March 12, 2001) earlier than the § 102(e) date of the Arai Patent Application Publication (April 23, 2001).

As discussed by the CAFC in *In re Gosteli*, 10 USPQ2d 1614, "if effective filing date for subject matter claimed in U.S. application is in issue, foreign application relied upon for priority under Section 119 must be examined to determine whether it supports, within meaning of 35 USC 112's first paragraph, what is claimed in U.S. application, and claims in issue are therefore entitled to benefit of foreign priority date only if foreign application properly supports such claims

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as required by Section 112." A review of the priority document shows that the subject matter of claim 3 is not described by the '883 priority document within the meaning of § 112, first paragraph.

Claim 3 requires the limitations of claim 2, which are properly supported by the priority document, and the additional limitation that the wax is a hydrocarbon wax. The certified translation of the '883 document shows a description of a wax having the noted DSC characteristic in document claim 1. The composition of the wax is further described on translation page 8 as polyolefin wax such as polypropylene having a low molecular weight, paraffin wax, Fischer-Tropsch wax, carnauba wax, candelilla wax, and rice wax. The remainder of the disclosure specifies characteristics of these types of wax. The examples use Fischer-Tropsch wax. Hydrocarbon waxes are not disclosed specifically. Furthermore, the waxes disclosed do not show possession of all hydrocarbon waxes, as permitted by the scope of the claims. Although polyolefins are typically hydrocarbons, they also are specific in that they are derived from C_nH_{2n} compounds. The term hydrocarbon would appear to include other waxes, such as those having aromatic hydrocarbons as reactants (e.g., styrene) and plural unsaturations (e.g., dienes). The other compounds recited, such as Fischer-Tropsch wax, carnauba wax, candelilla wax, and rice wax, typically have oxygen atoms presents and are not hydrocarbons, *per se*. For example, carnauba wax is an ester wax.

The priority document does not disclose a hydrocarbon wax in the toner of claim 3. As such, the Arai reference remains valid prior art because the priority claim does not describe the subject matter of this claim.

The rejection is maintained.

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Allowable Subject Matter

Claims 2, 5-8, 10, and 13 are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

cdr
12 December 2003


CHRISTOPHER RODEE
PRIMARY EXAMINER